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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,700	05/22/2006	Takashi Sugibuchi	58866US004	2986
32692 7590 01/03/2008 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER AHMED, SHEEBA	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 01/03/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com  
LegalDocketing@mmm.com

## Office Action Summary

Application No.

10/563,700

Applicant(s)

SUGIBUCHI, TAKASHI

Examiner

Sheeba Ahmed

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/28/06</u> .   | 6) <input type="checkbox"/> Other: ____                           |

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. The Preliminary Amendment submitted on January 5, 2006 has been entered in the above-identified application. Claims 1-5 have been cancelled. New Claims 6-9 are now pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites a rewritable and erasable writing sheet according to claim 6, wherein said mat material is present in an amount of about 3 to 10 wt% based on the weight of the information recording layer. It is unclear what is meant by the "mat material" in this instance. Is the weight percentage of the cured silicone particles and the release material in an amount of about 3 to 10 wt% based on the weight of the information recording layer? Appropriate correction of clarification is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (US 5,888,625 A).

Kobayashi et al. disclose an image recording paper comprising a substrate and a coating of a silicone compound and a finely divided material. The coating preferably contains besides the silicone compound a modified-silicone oil having in a molecule thereof a reactive group and this image recording paper eliminates a conflict between fixability and releasability of an image forming material and is easily reusable without altering the appearance of plain paper. The reusable recording paper comprises a substrate comprised primarily of a pulp fiber and a film thereon which is created by coating or impregnating the substrate with a liquid composition comprising a silicone compound and a finely divided material and thereafter drying the applied composition, wherein the silicone compound is capable of combining with the substrate and with the finely divided material by a chemical reaction. The film component containing the curable silicone compound strongly adheres to the substrate and does not come off the substrate (pulp fiber) while functioning as a release providing coating to an image forming material. That is, the film component does not migrate. Accordingly, it not only facilitates the removal of the image forming material but also semipermanently exhibits its function in the reusable recording paper. Besides, owing to the finely divided material which makes it possible to control the surface irregularity of the film so that the amount of remnant image forming material at the time of removal of the image forming

material is reduced, the performance of the film can be maintained for a long period of time. The thickness of the coated film is preferably in the range of 0.05 to 5.0 microns, exclusive of the thickness of the finely divided material. The amount of finely divided material as calculated with respect to the amount of the silicone compound is preferably in the range of 1 to 100 parts by weight of the finely divided material per 100 parts by weight of the silicone compound and the average particle diameter of the finely divided material is preferably in the range of 0.1 to 15 microns. EXAMPLE 2 recites a coating liquid containing 14 parts of silicone resin particles (TOSPEARL 130 having an average particle diameter of 3 microns) as a finely divided material. All limitations of claims 6-9 are disclosed in the above reference.

### ***Conclusion***

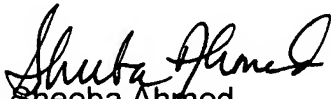
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Sheeba Ahmed  
December 18, 2007